

## **REMARKS**

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, Claims 2 and 4 have been cancelled. Claim 11 has been added.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Claim 11 corresponds in scope to claim 4. Claim 4 has been indicated as being allowable upon having been rewritten in independent form, including all of the limitations of the base claim and any intervening claim(s). Accordingly, claim 11, which is claim 4 so rewritten, is in condition for allowance.

It is respectfully submitted that claims 1, 3 and 7 are likewise allowable.

The Examiner rejects claim 1 under 35 U.S.C. §102 (f) as being anticipated by Onishi, U.S. Patent No. 5,769,365 (Onishi). Claims 1-3 and 7 were rejected under 35 U.S.C. §103 (a) as being unpatentable over Onishi in view of Kennedy, U.S. Patent No. 4,116,104 (Kennedy '104): It is respectfully

submitted that 1, 3 and 7 are patentable over Onishi and Kennedy '104 taken alone or in combination.

Specifically, claim 1 recites that the receiving member has at least two, extending in a longitudinal direction anchoring walls which have, in a locking position of the device, at least two respective engagement points with the corresponding retaining projections extending through respective guide openings.

As explained in the specification, the at least two engagement points of the anchoring walls with the retaining projections reliably prevent rotation of the receiving member and of the entire anchoring unit relative to the mounting rail. At the same time, a stable position of the gripping members relative to the retaining projections of the mounting rail is insured. This, in turn, insures that the attachment device can withstand application of high loads.

Onishi, as it is recognized in the Office Action does not disclose anchoring wall extending in a longitudinal direction.

The Office Action asserts that it would have been obvious with a receiving member having walls extending longitudinally as disclosed in Kennedy '104. Applicant respectfully disagrees with this assertion.

Firstly, applicant believes that Kennedy '104 is not particularly relevant. Kennedy '104 relates to a toggle bolt wing nut retainer for attachment of fixtures in blind bores in walls, whereas the present invention relates to an attachment device for attaching elongate object to constructional components using rails. The attachment of a fixture in a blind bore is not even remotely similar to an attachment of an object in an opening in a mounting rail. The retainer (10), which the Office Action refers to as "receiving member") is not comparable with the receiving member (10) according to the present invention. The guide slots (20) in Kennedy '104 do not have fixed locking positions. One of ordinary skill in the art would not have recognized that the retainer 10 could be used as a receiving member for attaching an object to a mounting rail.

Even assuming, *arguendo*, that Kennedy '104 is relevant, the combination of Onishi and Kennedy '104 would not result in a structure according to the present invention. The resulting attachment device would not have a receiving member with a plurality of guide openings, with the anchoring wall having engagement points with the retaining projections which extend through the respective openings. Furthermore, with the receiving member of Kennedy 104, the gripping projections (wings) would be subjected to action of the screw (32), which would make the attachment unit very unstable.

Since all claim limitations must be considered in an obviousness determination, and since the combination of Onishi and Kennedy '104 fails to disclose several of the important and recited elements and features of independent claim 1, it is respectfully submitted the present invention, as defined by claim 1, is not rendered obvious by the combination of Onishi and Kennedy '104 and is, therefore, patentably defines over said combination.

However, it is respectfully submitted that a *prima facie* case of obviousness has not been made.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would

have been led to combine the relevant teachings.” Id. At 1301 (emphasis in original).

The Federal Circuit demands that the determination of obviousness be based on a concrete evidence and rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence . . . . *In re Lee*, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002).

The Office Action does not rely on any evidence available in the prior art for the combination set forth in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

*In re Fritch*, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Sponnoble*, 160

U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Onishi and Kennedy '104 can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In view of the above, it is respectfully submitted that the combination of Onishi and Kennedy '104 does not make obvious the present invention, as

defined in Claim 1, and the present invention is patentable over said combination.

Claims 3 and 7 depend on Claim 1 and are allowable for the same reasons Claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 1, are not disclosed or suggested in the prior art. Thus, claim 3 recites that the anchoring walls extend parallel to the retaining projections and substantially about same in the locking position.

The Office Action asserts that once the combination is made, the walls would extend parallel to the retaining projections. However, no explanation is given why that would be the case.

The wing nut does not require the walls to extend parallel to the retaining projections.

## **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal



respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail and addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on May 12, 2005.

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